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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,594	08/30/2001	Takeshi Namikata	862.C2347	6419
5514	7590	08/09/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MARIAM, DANIEL G	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/941,594	NAMIKATA, TAKESHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL G MARIAM	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-6 and 8-10 is/are rejected.
- 7) Claim(s) 2,3 and 7 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 recites the limitation "a computer program constituting operating commands for implementing the image discrimination apparatus . ." which is non-statutory. Likewise, claim 10 recites the same limitation except claim 10 is directed to a method claim. A program is functional descriptive material, and is only statutory when embodied in a computer readable medium (See MPEP 2106).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 recites the limitation " . . . calculates the sum total of errors between the distances between the plurality of marks . ." in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 5-6 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuyama (5,771, 315).

With regard to claim 1, given the broadest reasonable interpretation, Matsuyama discloses an image discrimination, i.e., judgment, apparatus for discriminating a prescribed pattern contained in an original image (See for example, item 30, in Figure 4, and Fig. 12), comprising: extraction means, i.e., reading unit, for extracting, from an input original image, i.e., document, a plurality of marks (as shown in Fig. 12) having a prescribed color density and disposed in a predetermined positional relationship, i.e., the plurality of marks or symbols shown in Fig. 12 do have a predetermined positional relationship) (See for example, col. 15, lines 22-63; and Figs. 11, 12, and 15); calculation means (which also is performed by the input/output device “30”, in Fig. 4) for calculating, i.e., examining, the relative positional relationship of the plurality of marks extracted by said extraction means (See for example, col. 7, lines 50-57; and col. 8, lines 26-37); and discrimination means for discriminating whether or not the prescribed image pattern is present in the original image based upon the relative positional relationship calculated by said calculation means (See for example, col. 7, lines 57-61; and col. 17, lines 8-49) .

With regard to claim 4, a copier (item 40, in Fig. 4; and Fig. 19), which includes the image discrimination apparatus described in claim 1, for printing a copy an original based upon image information relating to the original to be copied, said copier having control means (See for example, item 34, in Fig. 4) which, when it has been determined that the prescribed image pattern is present in the original image, executes image processing different from that executed

when it is judged that the prescribed image pattern is not present the original image (See for example, items (S19-S20) and items S16-S18) respectively, in Fig. 19).

With regard to claim 5, the copier according to claim 4, wherein said control means inhibits, i.e., prevents or stops, printing when it has been determined that the prescribed image pattern is present in the original image (See for example, items S19 and S20).

Claim 6 is rejected the same as claim 1 except claim 6 is directed to a method claim. Thus, argument analogous to that presented above for claim 1 is equally applicable to claim 6.

With regard to claim 9, Matsuyama further discloses a computer program wherein commands for operating the image discrimination apparatus described in claim 1 are capable of being implemented (See col. 5, lines 4-6; and Fig. 19).

With regard to claim 10, Matsuyama further discloses a computer program constituting operating commands for implementing the image discrimination method described in claim 6 (See col. 5, lines 4-6; and Fig. 19).

#### ***Allowable Subject Matter***

7. Claims 2-3 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art to Matsuyama does not teach or fairly suggest comparing distances between the plurality of marks calculated at said calculation step and distances between the plurality of marks, which constitute the prescribed image pattern, stored in advance as a template, and determines whether or not the prescribed image pattern is present in accordance with result of the comparison. It is for this reason and in combination with

all of the other elements of the claims that claims 2-3 and 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 5010580, 5436735, 5434649, 5502575, 5640467, and 6493462.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G MARIAM whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DANIEL MARIAM**  
**PRIMARY EXAMINER**

August 2, 2004